

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY L. ZIMMERMAN, JOHN C. GOODWIN,
SCOTT A. BITNER, CHRISTOPHER M. HAYNES,
GREGORY H. CAMPBELL and KELLY S. HARREISON

MAILED

Appeal No. 2002-0888
Application 08/646,565

JAN 21 2004

ON BRIEF

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before THOMAS, JERRY SMITH, and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-19, which constitute all the claims in the application. An amendment after final rejection was filed on October 19, 1998 and was entered by the examiner.

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The disclosed invention pertains to a method and apparatus for managing electronic price label (EPL) overlay data as the EPL overlay data changes during operation of an EPL system.

Representative claim 1 is reproduced as follows:

1. A method of managing EPL overlay data as the EPL overlay data changes during operation of an EPL system comprising the steps of:

making a change to an EPL data file in the EPL system for an EPL;

marking the change;

recording a command to print an overlay;

reading the EPL data file for the marked change; and

creating a print file for printing an overlay containing the change.

The examiner relies on the following reference:

Kosarew 5,619,416 Apr. 08, 1997
(filed Sep. 14, 1995)

Claims 1-15 and 18 stand rejected under 35 U.S.C.

§ 102(e) as being anticipated by the disclosure of Kosarew.

Claims 16, 17 and 19 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Kosarew taken alone.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports the rejection of claims 1 and 5 but does not support the rejection of claims 2-4 and 6-19. Accordingly, we affirm-in-part.

We consider first the rejection of claims 1-15 and 18 under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Kosarew. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and

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Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he finds the invention of these claims to be fully met by the disclosure of Kosarew [final rejection, pages 2-4, incorporated into answer at page 3]. Appellants argue that each of the independent claims on appeal recites that the claimed operation is during operation of an EPL system (claims 1, 5 and 6) or during operation of an EPL system in a store (claims 2-4). Appellants assert that Kosarew describes a manufacturing process and is not during operation of an EPL system as claimed. Appellants argue that the portions of Kosarew relied on by the examiner have been misunderstood by the examiner and fail to support the examiner's findings [brief, pages 6-11]. The examiner responds that Kosarew updates EPL overlays even while they are in operation. The examiner asserts that the processing within Kosarew takes place while the EPLs are in effect at the store and the changes are then made at the store which constitutes "during operation of an EPL system in a store" as claimed [answer, page 3]. Appellants respond that the automatic and continuous printing of labels in Kosarew can not occur during EPL operation [reply brief].

We will not sustain the examiner's rejection of independent claims 2-4 and 6. Claims 2-4 recite that the method takes place "during operation of an EPL system in a store" while claim 6 recites "a store based computer." Kosarew relates to a process where a merchant who wishes to have an EPL system sends data to a company which then prints all the labels for use in the EPL system of the merchant. We agree with appellants that operations performed at the company in Kosarew do not take place during operation of an EPL system in a store nor does Kosarew disclose a store-based computer as claimed. The disclosed invention is intended to permit the store to update its EPL overlays without going outside the store. It is unreasonable to read the process steps taking place at the manufacturer in Kosarew as being part of an EPL system in a store as claimed. Therefore, we find that Kosarew fails to disclose at least one feature of the invention recited in claims 2-4 and 6. Since claims 7-15 and 18 depend from claim 6, we also do not sustain the examiner's rejection of these claims.

We reach a different conclusion with respect to independent claims 1 and 5. These claims recite that the method takes place "during operation of an EPL system." Thus, these claims do not require that the method take place within a store. We do not

agree with appellants' argument that the invention of Kosarew does not take place during operation of an EPL system because the EPL system operates at the store. Since claims which are different are presumed to have different scope, we do not read the phrase "in a store" into claims 1 and 5 because claims 2-4 include that limitation as a separate limitation. We agree with the examiner that there is no reason why the broad term "EPL system" cannot include the steps performed by a company such as in Kosarew for making the overlays which form part of the EPL labels which will be used in the store. Therefore, we find that the method disclosed by Kosarew takes place during operation of an EPL system as claimed.

With respect to the specific recitations of claims 1 and 5, the examiner has indicated how he reads these claims on the disclosure of Kosarew as noted above. Appellants' response to the examiner's findings of anticipation do not persuade us that the examiner's rejection is in error. Appellants simply broadly assert that the disclosure of Kosarew fails to support the examiner's findings, but these general assertions fail to identify why the examiner's findings with respect to the claim limitations, as broadly interpreted by the examiner, are erroneous. We find that the examiner has established a prima

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facie case of anticipation with respect to claims 1 and 5 which case has not been persuasively rebutted by appellants.

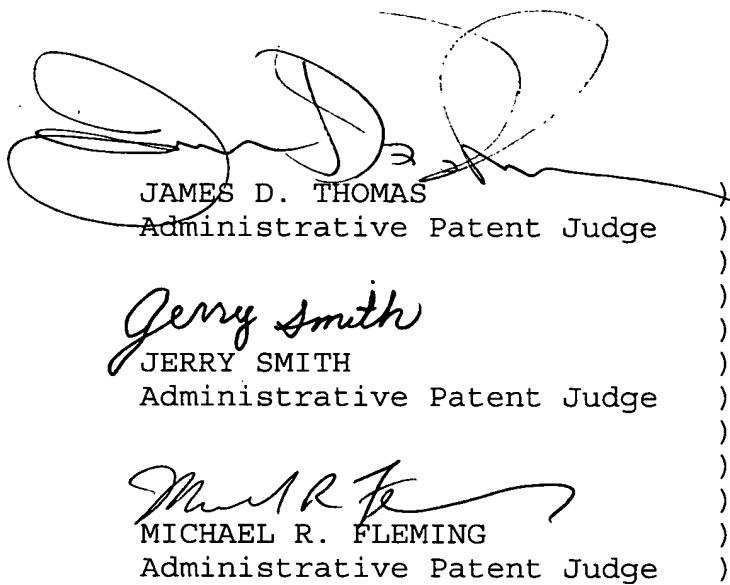
With respect to the rejection of claims 16, 17 and 19 under 35 U.S.C. § 103(a), these claims depend from claim 6 which was considered above. We note that the examiner's rejection under 35 U.S.C. § 103 fails to present any analysis which overcomes the deficiencies of Kosarew discussed above. Therefore, we do not sustain the examiner's rejection of claims 16, 17 and 19.

In summary, we have sustained the examiner's rejection of claims 1 and 5, but we have not sustained the examiner's rejection of claims 2-4 and 6-19. Therefore, the decision of the examiner rejecting claims 1-19 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART



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Jerry Smith)
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MICHAEL R. FLEMING)
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